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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,901	02/08/2002	Takatoshi Nishizawa	218129US2	8032
22850	7590	08/29/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER VO, HAI	
			ART UNIT 1771	PAPER NUMBER
			NOTIFICATION DATE 08/29/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary****Application No.**

10/067,901

**Applicant(s)**

NISHIZAWA ET AL.

**Examiner**

Hai Vo

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06/14/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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1. The 102 art rejections based on Calhoun (US 6,569,527) taken alone are withdrawn and changed to the 103 art rejections in view of the present amendment.  
Additionally, new ground of rejection is made in view of Balaji et al (US 6,726,969).
2. Other rejections based on Endo and Hatke separately have been withdrawn in view of the present amendment.
3. The art rejections over Cowell Senft are maintained.
4. The 112 claim rejections have been withdrawn in view of the present arguments.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 3-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Balaji et al (US 6,726,969). The recitation "50g or less" implies that the attractive force could get to zero. Similarly, the range from "-10 kV to +10 kV" allows the stretched film without charge potential. Therefore, any stretched films comprising a void-containing thermoplastic resin without charge potential would read on the claimed subject matter. Balaji teaches an in-mold forming label comprising a polyolefin resin and 50% by weight (table 2). The label is opaque (claim 12). The label is biaxially oriented (column 8, lines 43-45). The core is voided (column 8, lines 45-55). The

label contains an antistatic agent (column 6, lines 25-30). There is no application of charge potential on the label. Therefore, the label is free of charge potential. The label has a heat sealing layer (column 6, lines 58-60). Accordingly, Balaji anticipates the claimed subject matter.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO99/61521. Calhoun et al (US 6,569,527) will be relied on as an equivalent form of WO99/61521 for convenience. The recitation "50g or less" implies that the attractive force could get to zero. Similarly, the range from "-10 kV to +10 kV" allows the stretched film without charge potential. Therefore, any stretched films comprising a void-containing thermoplastic resin without charge potential would read on the claimed subject matter. Calhoun teaches a breathable film comprising a polyolefin resin and at least 10% by weight of inorganic filler (column 2, lines 45-50). The film is opaque (column 12, lines 1-3). The film is biaxially oriented (column 12, lines 40-45). The film has a porosity of 44.7% as shown in sample 2 of table 2. The porous film is useful as a packaging material for foods (column 13, lines 15-20). There is no application of the charge potential on the breathable film. Calhoun does

not specifically teach the porous film having heat sealing properties. However, it appears that Calhoun meets all the structural limitations as required by the claims. The breathable film comprises a polyolefin resin and at least 10% by weight of inorganic filler (column 2, lines 45-50). The film is opaque (column 12, lines 1-3). The film is biaxially oriented (column 12, lines 40-45). The film has a porosity of 44.7% as shown in sample 2 of table 2. Therefore, it is the examiner's position that the heat sealing property would be inherently present as like material has like property. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties.

Calhoun does not specifically teach the porous film having a size and a shape similar to those of the label. Note that the claims are completely silent as to a specific dimension as well as a specific shape of the label. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the porous film having a size and a shape similar to those of the label as depending upon the end uses of the products. This is in line with *In re Aller*, 105 USPQ 233 which holds discovering the optimum or workable ranges involves only routine skill in the art.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO99/61521 as applied to claim 1 above, and further in view of Sheth (US 4,777,073). Calhoun et al (US 6,569,527) will be relied on as an equivalent form of WO99/61521 for

convenience. Calhoun does not teach the breathable film comprising an antistatic agent. Sheth, however, teaches a breathable film comprising a polyolefin resin composition that includes an antistatic agent (column 5, lines 40-45). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ an antistatic agent in the breathable film because such is a conventional additive being added to the polyolefin resin of the breathable film. Sheth provides necessary details to practice the invention of Calhoun.

10. Claims 4, 5, 8, 10 and 11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cowell Senft (US 6,468,635). Cowell Senft discloses a film comprising a printing layer and a blotting layer as shown in figure 4. The film is stretched and has a surface potential between 5 kV to 30 kV, which is within the claimed range (column 5, lines 10-15, and 25-27). The printing layer is porous and opaque (column 3, lines 30-32; and column 6, lines 35-40). The printing layer is of polypropylene (column 6, lines 18-20). The films do not stick together (column 6, lines 1-2). Likewise, the attractive force between the films would be inherently present in the claimed range. The film is useful as a poster which is treated as a large label. Cowell Senft does not specifically disclose the heat sealing property. However, it appears that Cowell Senft meets all the structural limitations as required by the claims. The film comprises a printing layer and a blotting layer as shown in figure 4. The film is stretched and has a surface potential between 5 kV to 30 kV, which is within the claimed range (column 5, lines 10-15, and 25-27). The printing layer is porous and opaque (column 3, lines 30-32;

and column 6, lines 35-40). The printing layer is of polypropylene (column 6, lines 18-20). The films do not stick together (column 6, lines 1-2). Therefore, it is the examiner's position that the heat sealing property would be inherently present as like material has like property. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. This is also in line with *In re Spada*, 15 USPQ 2d 1655 (1990). Accordingly, Cowell Senft anticipates or strongly suggests the claimed subject matter.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cowell Senft (US 6,468,635). Cowell Senft teaches the porosity of the printing layer could be controlled as dependent on the particle dose level and subsequent etch duration (column 4, lines 10-13). Cowell Senft does not specifically disclose the porosity of the printing sheet. In view of the extremely wide range for the porosity and in the absence of evidence to the contrary, it is believed that it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the printing sheet having a porosity in the range instantly claimed motivated by the desire to provide sufficient ink absorbency to allow printing in inkjet printers.

12. The art rejections over Cowell Senft have been maintained for the following reasons. Cowell Senft teaches the film is useful as a poster which is treated as a large label. It appears that Cowell Senft meets all the structural limitations as required by the claims. The film comprises a printing layer and a blotting layer as shown in figure 4. The film is stretched and has a surface potential between 5 kV to 30 kV, which is within the claimed range (column 5, lines 10-15, and 25-27). The printing layer is

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porous and opaque (column 3, lines 30-32; and column 6, lines 35-40). The printing layer is of polypropylene (column 6, lines 18-20). The films do not stick together (column 6, lines 1-2). Therefore, it is the examiner's position that the heat sealing property would be inherently present as like material has like property. Accordingly, the art rejections are sustained.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HV

/Hai Vo/  
Primary Examiner, Art Unit 1771